

REMARKS/ARGUMENTS

Claims 1-45 are pending in this application, with claims 1, 9, 21, 30, 31, 33, 39, and 44 being the independent claims. In the July 16, 2003 Office Action, the Examiner rejected claims 1-44.¹

Based on the following Remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Priority

The Examiner has not granted Applicants' claim for priority under 35 U.S.C. § 120 of parent Application No. 09/026,036, which in turn claimed priority from Provisional Patent Application No. 60/038,276. The Examiner states that the parent application(s) contain different inventors. However, on May 30, 2003, Applicants filed a Request to Correct Inventorship, which identifies Charles Eldering and Thomas Eames as inventors of the present application in addition to Steve Sheppard and A.J. McInnis, who were initially identified as inventors. Messrs. Eldering and Eames are the inventors listed in the parent application. Accordingly, upon grant of the Applicants' Request to Correct Inventorship, Applicants' claim for priority under 35 U.S.C. § 120 would be proper. Applicants hereby request the Examiner to grant Applicants' Request to Correct Inventorship, and to reconsider Applicants' claim for priority.

¹ In the Office Action Summary, the Examiner indicated that claims 1-45 had been rejected. The Office Action itself, however, does not address claim 45. That claim is dependent on claim 44 which, for the reasons discussed below, is allowable.

Obviousness-Type Double Patenting Rejections

Under the judicially created doctrine of obviousness-type double patenting, the Examiner has provisionally rejected claims 1, 21, and 30 as obvious over claims 1-3 of U.S. Patent No. 6,317,884 ("the '884 patent"), and claims 9 and 31 as obvious over claims 11-12 of the '884 patent. Also under the judicially created doctrine of obviousness-type double patenting, the Examiner has provisionally rejected claims 1, 21, and 30 as obvious over claims 1, 3, 4, and 7 of U.S. Patent No. 6,493,875 ("the '875 patent"), and claims 9 and 31 as obvious over claims 14 and 16 of the '875 patent. Under the judicially created doctrine of obviousness-type double patenting, the Examiner has also provisionally rejected claims 1, 9, 21, 30, and 31 as obvious over claims 1, 16, 67, 67, and 71 respectively of co-pending Application No. 09/488,275 ("the '275 application"). Also under the judicially created doctrine of obviousness-type double patenting, the Examiner has provisionally rejected claims 1, 9, 21, 30, and 31 as obvious over claims 1, 18, 35, 45, and 46 respectively of co-pending Application No. 09/525,412 ("the '412 application"). Finally, under the judicially created doctrine of obviousness-type double patenting, the Examiner has provisionally rejected claims 1, 9, 21, 30, and 31 as obvious over claims 1, 19, 38, 48, and 49 respectively of co-pending Application No. 09/525,488 ("the '488 application").

A Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Prior Patent or a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a Pending Second Application, executed by the assignee of the above-captioned application, will be filed for each of the '884 patent, the '875 patent, the '275 application, and the '412 application ("Disclaimers"). A Statement Under 37 C.F.R. § 3.73(b) establishing the right to act on behalf of the assignee with regard to the above-captioned application will also be filed with the Disclaimers. The filing of a terminal disclaimer to obviate a rejection based on nonstatutory

double patenting is not an admission of the propriety of the rejection. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870 (Fed. Cir. 1991). The filing of a terminal disclaimer serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection. *Id.*; M.P.E.P. § 804.02. Based upon the timely filing of the Disclaimers and accompanying fee, Applicants respectfully submit that the obviousness-type double patenting rejections should be withdrawn.

With respect to the obviousness-type double patenting rejections over the '488 application, that application is now abandoned and is therefore no longer co-pending. Please refer to the attached Response to a Petition to Withdraw Application From Issue Pursuant to 37 CFR 1.313(c)(3). Accordingly, the Examiner is respectfully requested to withdraw the provisional obviousness-type double patenting rejections over the '488 application.

Rejections Under 35 U.S.C. § 102

The Examiner has rejected claims 39, 41, and 43 as being anticipated by U.S. Patent No. 5,812,184 to Martinez ("Martinez"). The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them.

Specifically, with respect to claim 39, Martinez does not disclose, for example, "an optical receiver for detecting [an] optical signal *and generating a corresponding pulse train*" and "a bias switch connected to said optical receiver, *said bias switch turning on and off in response to the pulse train*," as recited in claim 39 of the present application. In the discussion of claim 12 (page 14 of the July 16, 2003 Office Action), the Examiner discusses Martinez and contends that "[t]he AND gate receives pulse trains from the optical receiver 24 that are logic high '1's' and output[s] the logic high to the modulator 65" However, neither column 9, lines 8-20 of Martinez, cited by the Examiner, nor any other portion of the disclosure of

Martinez, discloses both an optical receiver that generates a pulse train and a bias switch that is responsive to said pulse train, as recited in claim 39 of the present application.

Claims 41 and 43 depend upon independent claim 39, and are therefore not anticipated by Martinez for at least the reasons discussed above with respect to claim 39.

Accordingly, it is respectfully submitted that claims 39, 41, and 43 are allowable.

Rejections Under 35 U.S.C. § 103

Claims 1-3, 8-10, 16, 21, 22, 24, 25, and 29

The Examiner rejected claims 1-3, 8-10, 16, 21, 22, 24, 25, and 29 under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,286,142 to Ehreth ("Ehreth") in view of U.S. Patent No. 5,574,964 to Hamlin ("Hamlin"). The Applicants respectfully disagree with these rejections and request the Examiner to reconsider them. With respect to independent claim 1, Ehreth fails to disclose or suggest "receiving channel select commands from remote control devices associated with a plurality of televisions, wherein at least a first channel select command is received by a receiver within [a] residential gateway," as recited in claim 1. Ehreth discloses a channel selection and signaling unit 50, which appears to receive channel select commands from remote control 70 in Ehreth. However, the channel selection and signaling unit 50 in Ehreth is not within the communications controller 30 of Ehreth, which according to the Examiner (p. 8) corresponds to the residential gateway of claim 1 of the present application. Thus, as the Examiner acknowledges (p. 8) Ehreth does not disclose "a receiver within the residential gateway" as required by claim 1. Nothing in the disclosure of Ehreth suggests that it would be beneficial to have a "receiver" 50 in the "residential gateway" 30, or that it would be possible to do so. Moreover, because each television 100 of Ehreth has a receiver 50 associated with it, there would be no need in Ehreth to provide a receiver 50 within the residential gateway 30.

Likewise, Hamlin, for example, does not teach or suggest “receiving channel select commands from remote control devices associated with a plurality of televisions, wherein at least a first channel select command is received by a receiver within [a] residential gateway” as recited in claim 1. Instead, Hamlin discloses a single remote controller 42, which is used to program the signal distribution system of Hamlin. Accordingly, as neither Ehreth nor Hamlin teaches or suggests these features of independent claim 1, the combination of Ehreth and Hamlin also fails to teach or suggest the limitations of that claim. Moreover, there is no motivation or suggestion to combine Ehreth and Hamlin. For example, while Ehreth discloses a remote controller associated with each one or group of television receivers in a system, Hamlin discloses and suggests a single remote controller for all of the receiving units in the system.

Claims 2-3 and 8 depend upon claim 1, and are therefore allowable for at least the reasons discussed above with respect to claim 1.

With respect to claim independent claim 9, Ehreth does not disclose, for example, “receiving signals, including video signals, from a telecommunications network, wherein the received video signals correspond to the channel select commands” as recited in claim 9 of the present application. Ehreth notes (col. 3, lines 15-18) that the “[b]roadband/narrowband network may provide . . . only those signals requested by communication controller 30,” which, according to the Examiner, corresponds to the residential gateway as recited in claim 9 of the present application. However, Ehreth does not teach or suggest that video signals are received by a residential gateway that correspond to channel select commands, as claimed. In addition, in Ehreth, there is no disclosure or suggestion of the steps of “a video processor for processing the received video signals to produce television signals” or “a video bus for transporting the received video signals to said video processor,” as recited in claim 9 of the present application.

Furthermore, Hamlin also fails to teach or suggest several aspects of claim 9, including but not limited to receiving a video signal from a telecommunications network in corresponding to channel select commands, which is also not disclosed or suggested by Ehreth. Accordingly, as neither Ehreth nor Hamlin teach or suggest the features of claims 9, the combination of Ehreth and Hamlin also does not teach or suggest the limitations of this claim.

Claims 10 and 16 depend upon claim 1, and are therefore allowable for at least the reasons discussed above with respect to claim 1.

Independent claim 21 is allowable for at least the reasons discussed above with respect to claims 1 and 9. Specifically, as discussed above with respect to claim 9, neither Ehreth nor Hamlin teaches or suggests “transmitting . . . channel select commands from the network interface module to [a] telecommunications network,” as recited in claim 21 of the present application. Claims 22, 24, 25, and 29 depend upon claim 21, and are therefore allowable for at least the reasons discussed above with respect to claim 21.

Accordingly, it is respectfully submitted that claims 1-3, 8-10, 16, 21, 22, 24, 25 and 29 are allowable.

Claims 4-7, 11, 14-17, 20, 23, 26-28, 30-33, and 36

The Examiner rejected claims 4-7, 11, 14-17, 20, 23, 26-28, 30-33, and 36 under 35 U.S.C. § 103 as being obvious over Ehreth in view of Hamlin and further in view of U.S. Patent No. 5,500,691 to Martin et al. (“Martin”). Claims 4-7 depend upon independent claim 1; claims 11, 14-17, and 20 depend upon claim 9; and claims 23 and 26-28 depend upon independent claim 21. As discussed in further detail above, neither Ehreth nor Hamlin, alone or in combination, teach or suggest all the features of independent claims 1, 9, and 21, and there is no motivation to combine these references. Martin discloses a system for setting up a remote

control system that uses both RF and infrared signals, but fails to disclose or suggest the features of claims 1, 9, and 21 that are not taught by Ehreth in view of Hamlin, including for example receiving a video signal from a telecommunications network in response to a received channel select command, or receiving channel select commands from remote control devices associated with a plurality of televisions, wherein at least a first channel select command is received directly by a receiver within the residential gateway. Thus, the reference to Ehreth in view of Hamlin and further in view of Martin also fails to teach or suggest the limitations of independent claims 1, 9, and 21. In addition, there is no motivation or suggestion to combine Ehreth and Hamlin, or to combine either of these references with Martin.

Independent claim 30 is allowable for at least the reasons discussed above with respect to claims 9 and 21 and with respect to claims 4-7, 11, 14-17, 20, 23, and 26-28. Specifically, as discussed in greater detail above, Ehreth, Hamlin, and Martin, alone or in combination, fail to teach or suggest “transmitting . . . channel select commands to the telecommunications network.”

Independent claim 31 is allowable for at least the reasons discussed above with respect to claims 9 and 21 and with respect to claims 4-7, 11, 14-17, 20, 23, 26-28, and 30. Specifically, as discussed in greater detail above, Ehreth, Hamlin, and Martin, alone or in combination, fail to teach or suggest “a network interface module for transmitting upstream signals, including channel select commands, to [a] telecommunications network” Claim 32 depends upon claim 31, and is therefore also allowable for at least the reasons discussed in this Response with respect to claim 31.

Independent claim 33 is allowable for at least the reasons discussed above with respect to claims 9 and 21 and with respect to claims 4-7, 11, 14-17, 20, 23, 26-28, and 30-32. Specifically, as discussed in greater detail above, Ehreth, Hamlin, and Martin, alone or in

combination, fail to teach or suggest “a network interface module for transmitting upstream signals, including channel select commands, to [a] telecommunications network” Claim 36 depends upon claim 33, and is therefore also allowable for at least the reasons discussed in this Response with respect to claim 33.

Accordingly, it is respectfully submitted that claims 4-7, 11, 14-17, 20, 23, 26-28, 30-33, and 36 are allowable.

Claims 12, 13, 34, 35, 42, 44, and 45

The Examiner rejected claims 12, 13, 34, 35, 42, and 44 under 35 U.S.C. § 103 as being obvious over Ehreth in view of Hamlin and further in view of Martin in further view of Martinez. Claims 12 and 13 depend upon claim 9; claims 34 and 35 depend upon independent claim 33, and claim 42 depends upon independent claim 39. As discussed in further detail above, Ehreth, Hamlin, and Martin, alone or in combination, fail to teach or suggest all the features of independent claims 9, 33, and 39, and there is no motivation to combine these references. Martinez discloses a system for enabling data and interactive services over a CATV system, but fails to disclose or suggest the features of claims 9, 33, and 39 that are not taught by Ehreth in view of Hamlin in further view of Martin, including for example receiving a video signal from a telecommunications network in response to a received channel select command. Thus, the reference to Ehreth in view of Hamlin and further in view of Martin in further view of Martinez also fails to teach or suggest the limitations of independent claims 9, 33, and 39. In addition, there is no motivation or suggestion to combine Ehreth, Hamlin, and Martin, or to combine any of these references with Martinez.

Independent claim 44 is allowable for the reasons discussed above with respect to the rejection of claim 39 under 35 U.S.C. § 102. Specifically, as discussed in greater detail

above, Martinez does not disclose, for example, “an optical receiver for detecting [an] optical signal *and generating a corresponding pulse train*” and “a bias switch connected to said optical receiver, *said bias switch turning on and off in response to the pulse train*,” as recited in claim 44 of the present application. Claim 45 depends from claim 44, and is therefore allowable for at least the reasons discussed in this Response with respect to claim 44.

Accordingly, it is respectfully submitted that claims 12, 13, 34, 35, 42, 44 (and 45) are allowable.

Claims 18 and 37

The Examiner rejected claims 18 and 37 under 35 U.S.C. § 103 as being obvious over Ehreth in view of Hamlin and further in view of Martin in further view of U.S. Patent No. 5,521,631 to Budow et al. (“Budow”). Claim 18 depends upon independent claim 9; and claim 37 depends upon independent claim 33. As discussed in further detail above, Ehreth, Hamlin, and Martin, alone or in combination, fail to teach or suggest all the features of independent claims 9 and 33, and there is no motivation to combine these references. Budow discloses an interactive digital video services system, but does not disclose or suggest the features of claims 9 and 33 that are not taught by Ehreth in view of Hamlin in further view of Martin, including for example receiving a video signal from a telecommunications network in response to a received channel select command. Thus, the reference to Ehreth in view of Hamlin in further view of Martin and further in view of Budow does not teach or suggest the limitations of independent claims 9 and 33. In addition, there is no motivation or suggestion to combine Ehreth, Hamlin, and Martin.

Accordingly, it is respectfully submitted that claims 18 and 37 are allowable.

Claims 19 and 38

The Examiner rejected claims 19 and 38 under 35 U.S.C. § 103 as being obvious over Ehreth in view of Hamlin and further in view of Martin and Budow, and in further view of U.S. Patent No. 5,901,340 to Flickinger et al. ("Flickinger"). Claim 19 depends upon independent claim 9; and claim 38 depends upon independent claim 33. As discussed in further detail above, Ehreth, Hamlin, Martin, and Budow, alone or in combination, fail to teach or suggest all the features of independent claims 9 and 33, and there is no motivation to combine these references. Flickinger discloses a wideband signal distribution system, but does not disclose or suggest the features of claims 9 and 33 that are not taught by Ehreth in view of Hamlin in further view of Martin and Budow, including for example receiving a video signal from a telecommunications network in response to a received channel select command. Thus, the reference to Ehreth in view of Hamlin in further view of Martin, Budow, and Flickinger also does not teach or suggest the limitations of independent claims 9 and 33. In addition, there is no motivation or suggestion to combine Ehreth, Hamlin,, Martin, and Budow, or to combine either of these references with Flickinger.

Accordingly, it is respectfully submitted that claims 19 and 38 are allowable.

Claim 40

The Examiner rejected claim 40 under 35 U.S.C. § 103 as being obvious over Martinez. Claim 40 depends upon independent claim 39. As discussed above with respect to the rejection of claim 39 under 35 U.S.C. § 102, Martinez does not teach or suggest all the features of independent claim 39.

Accordingly, it is respectfully submitted that claim 40 is allowable.

As explained in this Response, all outstanding rejections have been overcome, and each of the presently pending claims in this application is believed to be in immediate condition for allowance. Applicants respectfully request that the Examiner withdraw all objections and rejections, and allow claims 1-45, passing this application to issue.

It is not believed that any additional extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to our Deposit Account No. 50-0740, under Docket No. 025684.113-US.

If the undersigned attorney can be of any assistance in advancing prosecution, please call him at (202) 662-5468.

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Respectfully submitted,
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